

Express Mail No. EV809055860US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants:	Max Aebi et al.	Confirmation No.:	3676
Application No.:	10/538,542		
Int'l Appln. No.:	PCT/CH02/00706	I.A. Filing Date:	December 17, 2002
For:	INTERVERTEBRAL IMPLANT COMPRISING JOINT PARTS THAT ARE MOUNTED TO FORM A UNIVERSAL JOINT	Attorney Docket:	8932-1181-999 (new) (formerly LUS-16099)

New York, New York 10017
January 8, 2007

Mail Stop PCT
Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Office of PCT Legal Administration

RENEWED PETITION UNDER 37 C.F.R. § 1.137(b)

Sir:

Applicants hereby renew their Petition For Revival Of An International
Application For Patent Designating The U.S., Abandoned Unintentionally Under 37 C.F.R.
§ 1.137(b).

On September 22, 2006, applicants filed the said Petition For Revival and a
Petition For Filing By Other Than All Inventors Under 37 C.F.R. § 1.47(a).

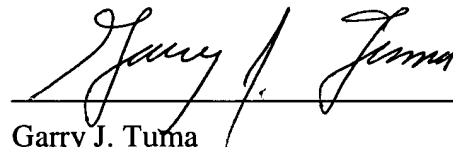
On November 7, 2006, the USPTO mailed a Decision On Petition dismissing both the Petition For Revival and the Petition For Filing By Other Than All Inventors (copy of Decision attached).

Applicants have just recently received a Declaration And Power Of Attorney executed on January 3, 2007 by previously uncooperative joint-inventor Max Aebi. A copy of the executed Declaration is attached.

Accordingly, applicants do not renew their Petition For Filing By Other Than All Inventors, but do renew their Petition For Revival of this application.

Because this Renewed Petition is being filed within two months of the November 7, 2006 mail date of the Decision On Petition (January 7, 2007 was a Sunday), no fee is believed due. However, if for any reason a fee is due in connection with this Renewed Petition, please charge that fee to Deposit Account No. 50-3013. A duplicate copy of this Renewed Petition is enclosed.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Garry J. Tuma", is written over a horizontal line.

Garry J. Tuma
Registration No. 40,210
Attorney for Applicants

JONES DAY
Customer No. 51832
222 East 41st Street
New York, New York 10017
(212) 326-3939



07 NOV 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

008932-1181-999

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Jones Day
222 East 41st Street
New York, New York 10017

NOV 10 2006

G. Tuma

In re Application of
AEBI et al.
Application No.: 10/538,542
PCT No.: PCT/CH02/000706
Int. Filing: 17 December 2002
Priority Date: None
Attorney Docket No.: LUS-16099
For: INTERVERTEBRAL IMPLANT
COMPRISING JOINT PARTS THAT
ARE MOUNTED TO FORM A
UNIVERSAL JOINT

DECISION ON PETITION

Response to Petition
Decision Due 11/7/07
JL

This decision is in response to applicants' "Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b)" and "Petition under 37 CFR 1.47(a)" filed 22 September 2006 in the above-captioned application. The requisite \$1500 petition fee for the filing of a petition under 37 CFR 1.137(b) and the requisite \$200 petition fee have been submitted. The above captioned national stage application became abandoned for failure to submit an oath or declaration within the time period set forth in the Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed 25 November 2005.

BACKGROUND

On 17 December 2002, applicants filed international application PCT/CH02/000706, which claimed no priority date. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 01 July 2004. Pursuant to 37 CFR 1.495, the period for paying the basic national fee in the United States expired 30 months from the international filing date, 17 June 2005.

On 10 June 2005, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a translation of the international application; an application data sheet; and a preliminary amendment.

On 25 November 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

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On 04 August 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 25 November 2005 within the time period set therein.

On 22 September 2006, applicants filed a "Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b)" and a Petition under 37 CFR 1.47(a).

DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional delay must be accompanied by: (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). Applicants have satisfied Items (2)-(4).

In order to comply with the proper response requirement of item (1) above for revival under 37 CFR 1.137(b), applicants submitted the present Petition Under 37 CFR 1.47(a). Under the present circumstances, in order for the response requirement, item (1) above, to be satisfied, the petition to accept the application without the signature of Max Aebi must be grantable.

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1) and (4) have been satisfied.

Regarding item (2) above, petitioner states that Max Aebi has refused to sign the application. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

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When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR-1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner states that Max Aebi has refused to sign the application. A review of the present petition and the accompanying papers reveals that applicants have not satisfied item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers to Max Aebi. The statement of Carrie A. McPherson states that a copy of the application papers were sent (via electronic mail) to Max Aebi on August 22, 2006. A copy of the electronic mail has been provided. However, petitioner fails to include evidence to demonstrate that the materials were actually received by the nonsigning inventor. (The "Delivery Status Notification" only confirms delivery, not receipt.) Where the Office is being asked to accept the silence of the nonsigning inventor as evidence of a refusal to sign, petitioner must provide some evidence that the application materials have been received by the nonsigning applicant.

Regarding item (3) above, a clear statement of the last known address of the nonsigning inventor has not been provided. In situations where an inventor does not execute the oath or declaration, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary. (See MPEP §605.03)

For the above reasons, it would not be appropriate to accept this application without the signature of Max Aebi at this time and the application remains abandoned.

CONCLUSION

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice and the application remains **ABANDONED**.

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration

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request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a) and 37 CFR 1.137(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to:
Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box
1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the
attention of the Office of PCT Legal Administration.



Anthony Smith
Attorney-Advisor
Office PCT Legal Administration
Tel.: 571-272-3298
Facsimile: 571-273-0459

DECLARATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below at 201 et seq. beneath my name.

I believe I am the original, first and sole inventor if only one name is listed at 201 below, or an original, first and joint inventor if plural names are listed at 201 et seq. below, of the subject matter which is claimed and for which a patent is sought on the invention entitled

INTERVERTEBRAL IMPLANT COMPRISING JOINT PARTS THAT ARE MOUNTED TO FORM A UNIVERSAL JOINT

and for which a patent application:

☒ was filed in the United States on June 10, 2005 as Application No. 10/538,542 and amended on even date, said application being a National Stage of:

☒ PCT International Application No. PCT/CH02/000706, filed on December 17, 2002

I hereby state that I have reviewed and understand the contents of the above identified application, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, §1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, §119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

EARLIEST FOREIGN APPLICATION(S), IF ANY, FILED PRIOR TO THE FILING DATE OF THE APPLICATION				
APPLICATION NUMBER	COUNTRY	DATE OF FILING (day, month, year)	PRIORITY CLAIMED	
			YES <input type="checkbox"/>	NO <input type="checkbox"/>
			YES <input type="checkbox"/>	NO <input type="checkbox"/>

I hereby claim the benefit under Title 35, United States Code, §119(e) of any United States provisional application(s) listed below.

PROVISIONAL APPLICATION NUMBER	FILING DATE

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code §112. I acknowledge the duty to disclose information known to me which is material to patentability as defined in Title 37, Code of Federal Regulations, §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

NON-PROVISIONAL APPLICATION NO.	FILING DATE	STATUS		
		PATENTED	PENDING	ABANDONED

POWER OF ATTORNEY: As a named inventor, I hereby appoint the Practitioners of Customer Number 51832, whose address is Jones Day, 222 East 41st Street, New York, New York 10017, my attorneys, to prosecute this application, and to transact all business in the Patent and Trademark Office connected therewith.

SEND CORRESPONDENCE TO:		JONES DAY 222 East 41st Street, New York, NY 10017 PTO Customer No. 51832		DIRECT TELEPHONE CALLS TO: JONES DAY DOCKETING 212-901-9028	
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.					
2 0 1	FULL NAME OF INVENTOR	LAST NAME Aebi	FIRST NAME Max	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Bern	STATE OR FOREIGN COUNTRY Switzerland	COUNTRY OF CITIZENSHIP Switzerland	
	POST OFFICE ADDRESS	STREET Gerechtigkeitsgasse 48	CITY Bern	STATE OR COUNTRY Switzerland	ZIP CODE CH-3011
	SIGNATURE OF INVENTOR 201			DATE Jan 3, 2007	
2 0 2	FULL NAME OF INVENTOR	LAST NAME Frigg	FIRST NAME Robert	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Bettlach	STATE OR FOREIGN COUNTRY Switzerland	COUNTRY OF CITIZENSHIP Switzerland	
	POST OFFICE ADDRESS	STREET Mattenweg 8	CITY Bettlach	STATE OR COUNTRY Switzerland	ZIP CODE CH-2544
	SIGNATURE OF INVENTOR 202			DATE	
2 0 3	FULL NAME OF INVENTOR	LAST NAME Burkard	FIRST NAME Dominique	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Gretzenbach	STATE OR FOREIGN COUNTRY Switzerland	COUNTRY OF CITIZENSHIP Switzerland	
	POST OFFICE ADDRESS	STREET Hasengasse 6	CITY Gretzenbach	STATE OR COUNTRY Switzerland	ZIP CODE CH-5014
	SIGNATURE OF INVENTOR 203			DATE	
2 0 4	FULL NAME OF INVENTOR	LAST NAME Lechmann	FIRST NAME Beat	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Bettlach	STATE OR FOREIGN COUNTRY Switzerland	COUNTRY OF CITIZENSHIP Switzerland	
	POST OFFICE ADDRESS	STREET Grenchenstrasse 29a	CITY Bettlach	STATE OR COUNTRY Switzerland	ZIP CODE CH-2544
	SIGNATURE OF INVENTOR 204			DATE	

2 0 5	FULL NAME OF INVENTOR	LAST NAME Pavlov	FIRST NAME Paul	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Nijmegen	STATE OR FOREIGN COUNTRY Netherlands	COUNTRY OF CITIZENSHIP Netherlands	
	POST OFFICE ADDRESS	STREET Louiseweg 5	CITY Nijmegen	STATE OR COUNTRY Netherlands	ZIP CODE NL-6523
	SIGNATURE OF INVENTOR 205			DATE	
2 0 6	FULL NAME OF INVENTOR	LAST NAME Mathys Jr.	FIRST NAME Robert	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Bettlach	STATE OR FOREIGN COUNTRY Switzerland	COUNTRY OF CITIZENSHIP Switzerland	
	POST OFFICE ADDRESS	STREET Chrütziacherstrasse 11	CITY Bettlach	STATE OR COUNTRY Switzerland	ZIP CODE CH-2544
	SIGNATURE OF INVENTOR 206			DATE	